

## **REMARKS**

In response to the Office Action dated August 11, 2008, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks. The Assignee respectfully submits that pending claims distinguish over the cited documents of record.

Claims 1-20 are pending in this application.

### **Rejections under § 102 (b)**

The Office rejected claims 1-2, 8, 11-12, 14-15, and 18-19 under 35 U.S.C. § 102 (b) as allegedly being anticipated by U.S. Patent 6,259,772 to Stephens, *et al.* A claim, however, is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”).

These claims, though, are not anticipated by *Stephens*. These claims recite, or incorporate, many features that are not disclosed or suggested by *Stephens*. Independent claim 1, for example, recites “*retrieving a voice communications address and another voice communications address from the profile.*” Support for such features may be found at least in the as-filed application at paragraph [0025]. Independent claim 1 also recites “*routing the message to a destination Internet Protocol address*” and “*when an off-hook condition is detected at the voice communications address within a pre-selected time period from the routing of the message, then automatically establishing a voice connection between the voice communications address and the another voice communications address*” (emphasis added). Support for such features may be found at least in the as-filed application at paragraph [0025]. Independent claim 1 is reproduced below, and independent claims 11, 12, 14, and 18 recite similar features.

[c01] A method, comprising:

accessing a profile storing information for generating a message;  
at a time indicated in the profile, generating the message;  
retrieving a voice communications address and another voice communications  
address from the profile;  
routing the message to a destination Internet Protocol address; and  
when an off-hook condition is detected at the voice communications address  
within a pre-selected time period from the routing of the message, then automatically  
establishing a voice connection between the voice communications address and the  
another voice communications address.

*Stephens* cannot anticipate these features. *Stephens* discusses enhancements to AT&T's "True Message" service in which a network sets up a call after delivering a voicemail message. See U.S. Patent 6,259,772 to Stephens, *et al.* at column 1, lines 35-50 and at column 3, lines 30-60. Still, though, *Stephens* fails to teach or suggest "routing the message to a destination Internet Protocol address" and "when an off-hook condition is detected at the voice communications address within a pre-selected time period from the routing of the message, then automatically establishing a voice connection between the voice communications address and the another voice communications address" (emphasis added). The patent to Stephens, *et al.* simply fails to contemplate a message to an I.P. address and detecting an off-hook condition at a voice address. *Stephens* also fails to contemplate an automatically established voice connection between two different voice communication addresses. Because *Stephens* completely fails to teach or suggest at least these features, *Stephens* cannot anticipate the independent claims.

Claims 1-2, 8, 11-12, 14-15, and 18-19, then, are not anticipated. The independent claims recite many features that are not disclosed or suggested by *Stephens*. Their respective dependent claims incorporate these same features and recite additional features. Claims 1-2, 8, 11-12, 14-15, and 18-19, then, cannot be anticipated, so the Office is respectfully requested to remove the § 102 (b) rejection of these claims.

**Rejection of Claims under § 103 (a) over Stephens & Levy**

Claims 3-7, 13, 17, and 20 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Stephens* in view of U.S. Patent 6,556,997 to Levy. These claims, though, respectively depend from independent claims 1, 12, 14, and 18, so these claims incorporate the same distinguishing features. As the above paragraphs explained, *Stephens* fails to teach or suggest all the features of the independent claims, and *Levy* does not cure these deficiencies. *Levy* extracts information from web pages or servers for delivery to a cellular phone. Still, though, the combined teaching of *Stephens* with *Levy* fails to teach or suggest sending a message to an I.P. address and detecting an off-hook condition at a voice address. *Stephens* with *Levy* also fails to contemplate an automatically established voice connection or call when an “off-hook condition” is detected. One of ordinary skill in the art, then, would not think that the independent claims, and thus claims 3-7, 13, 17, and 20, are obvious over *Stephens* with *Levy*. The Office is thus respectfully requested to remove the § 103 (a) rejection of these claims.

**Rejection of Claims under § 103 (a) over *Stephens* & *Jenkins***

Claims 9, 10, and 16 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Stephens* in view of U.S. Patent 6,950,502 to Jenkins.

*Jenkins*, however, cannot be cited against the pending claims. Documents that would qualify as “prior art” under 35 U.S.C. § 102 (e), 102 (f), or 102 (g) shall not preclude patentability when commonly owned at the time of invention, but, developed by another person. See 35 U.S.C. § 103 (c). *Jenkins* is a U.S. Patent with an earlier filing date (August 23, 2002) and with a different inventive entity. *Jenkins*, then, qualifies as a § 102 (e) document. *Jenkins* and this application were also commonly owned at the time of invention by the same assignee (namely, BellSouth Intellectual Property Corporation, now doing business as AT&T Intellectual Property I, LP). The Assignee, then, respectfully asserts that *Jenkins* cannot be cited against the pending claims. The Office is thus respectfully requested to remove the § 103 (a) rejection of these claims based on any combination involving *Jenkins*.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", with a stylized, cursive script.

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